UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,077	02/05/2001	Dimitri Kanevsky	YOR920000475US1(13823)	9551

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EXAMINER
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ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/777,077	KANEVSKY ET AL.
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>22 February 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,10-20 and 22-30</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,10-20 and 22-30</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>02 January 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 10-20, and 22-30 have been examined.

Prosecution is hereby reopened following Applicants' Appeal Brief of February

22, 2005; some of the rejections are new or modified.

Claim Objections

Claims 14, 15, 16, 25, and 26 are objected to because of the following

informalities: In the fourth and fifth lines of claim 14, "the computer readable medium"

lacks antecedent basis. Appropriate correction is required.

Claim 10 is objected to because of the following informalities: In the second line

of claim 10, "in PC" is unclear, and should presumably be "in a personal computer."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. The specification discloses degrading network

bandwidth, as recited in claim 1, and degrading CPU processing speed, as recited in claim 22, which depends on claim 1, but does not disclose that both are done together.

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses degrading network bandwidth, as recited in claim 1, and producing tactile stimulus, as recited in claim 23, which depends on claim 1, but does not disclose that both are done together.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses degrading network bandwidth, as recited in claim 1, and producing unpleasant olfactory stimulus, as recited in claim 24, which depends on claim 1, but does not disclose that both are done together.

Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses degrading CPU

processing speed, as recited in claim 14, and degrading network bandwidth, as recited in claim 25, which depends on claim 14, but does not disclose that both are done together.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses degrading CPU processing speed, as recited in claim 14, and producing tactile stimulus, as recited in claim 26, which depends on claim 14, but does not disclose that both are done together.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses degrading network bandwidth, as recited in claim 17, and degrading CPU processing speed, as recited in claim 27, which depends on claim 17, but does not disclose that both are done together.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses degrading network

bandwidth, as recited in claim 17, and producing tactile stimulus, as recited in claim 28, which depends on claim 17, but does not disclose that both are done together.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses producing tactile stimulus, as recited in claim 20, and degrading network bandwidth, as recited in claim 29, which depends on claim 20, but does not disclose that both are done together.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses producing tactile stimulus, as recited in claim 20, and degrading CPU processing speed, as recited in claim 30, which depends on claim 20, but does not disclose that both are done together.

Claim 20 and its dependents, claims 29 and 30, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing a user computer with the trial version of a software application, diminishing the performance of the trial version after a defined period of time, etc., does not reasonably provide enablement for the step of diminishing the performance of the trial software

including the step of producing tactile stimulus. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. Ordinary computers do not have the capacity to produce tactile stimulus in response to program instructions; therefore, whatever instructions a person skilled in the art of computer programming might write, they would not be operative in a normal computing machine. The specification does not describe special computers built to provide tactile stimulus, or a method of causing ordinary computers to provide tactile stimulus according to an application program.

Claims 23, 26, and 28 also recite producing tactile stimulus, and are held to lack proper enablement on the same grounds as claim 20.

Claim 24 recites means to produce unpleasant olfactory stimulus, and therefore lacks proper enablement on essentially the same grounds as claim 20. Ordinary computers do not have the capacity to produce unpleasant (or even pleasant) olfactory stimulus in response to program instructions; therefore, whatever instructions a person skilled in the art of computer programming might write, they would not be operative in a normal computing machine. The specification does not describe special computers built to provide olfactory stimulus, or a method of causing ordinary computers to provide olfactory stimulus according to an application program.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1, 10-13, and 22-24

Claims 1, 10-13, and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Allen (U.S. Patent 6,041,316). As per claim 1, Allen discloses an

application system running in a processing unit for changing the appearance and

performance generated by a specified application, the system comprising: a timer for

measuring time; and means, responsive to the timer, to change, after receipt of the

specified application by the central processing unit, the appearance or performance

generated by the specified application according to a timed procedure to encourage a

user of the application to abandon this specified application and to purchase a new

version of the specified application (column 7, line 11, through column 8, line 56). Allen

discloses, in particular, that the CPU is connected to a network to receive data

therefrom over a bandwidth (column 8, lines 26-38; see also Figure 1). Allen does not

quite expressly disclose means to degrade said network bandwidth, but does disclose

accessing an audio database, and receiving degraded versions of music "with an audio

quality level at or below that produced over a standard telephone line" (column 8, lines

6-15), which could surely be accomplished by in fact degrading the bandwidth.

Furthermore, Allen discloses that many variations can be made in the arrangements

shown, including the interconnections between the user terminals, the network, and the

provider database, and the manner of partially degrading a particular type of data

(column 8, line 57, through column 9, line 4). Degrading the bandwidth is held to be

such a variation, one of the numerous and functionally equivalent techniques the skilled

artisan would have found obvious in view of the Allen disclosure, which teaches

alternative solutions to the same basic problem addressed by Applicant.

As per claim 10, Allen discloses that changes are obtained by operations in a

computer (column 7, line 11, through column 8, line 56), and since the operations of a

computer involve its drives, the changes are therefore obtained by manipulating drives

in a PC or other computer.

As per claim 11, Allen discloses that users pay money or view advertisements to

reduce or eliminate degradation (Abstract).

As per claim 12, Allen further discloses that money is paid to one of a software manufacturer, seller, third party, or degradation service provider (Abstract; column 5, lines 27-57).

As per claim 13, Allen further discloses that the amount of degradation is related to the amount of money spent (Abstract; column 5, lines 27-57).

As per claim 22, a central processing unit inherently has a processing speed, but Allen does not disclose means to degrade said processing speed. However, Allen does disclose that many variations can be made in the arrangements shown, including the interconnections between the user terminals, the network, and the provider database, and the manner of partially degrading a particular type of data (column 8, line 57, through column 9, line 4). Degrading the processing speed is held to be such a variation, one of the numerous and functionally equivalent techniques the skilled artisan would have found obvious in view of the Allen disclosure, which teaches alternative solutions to the same basic problem addressed by Applicant. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the means to change the appearance or performance of the specified application include means to degrade the CPU processing speed, for the obvious advantage, taught by Allen, of encouraging a user to purchase a non-degraded version of the application.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent 6,041,316) as applied to claim 1 above, and further in view of Gupta (U.S. Patent 6,459,364). Allen does not disclose means to produce tactile stimulus, but

Gupta teaches means to produce tactile stimulus (Abstract; column 2, lines 10-49;

Figures 1 and 2). Hence, it would have been obvious to one of ordinary skill in the art of

electronic commerce at the time of applicant's invention to have the means to change

the appearance or performance of the specified application include means to produce

tactile stimulus, for the obvious advantage, taught by Allen, of encouraging a user to

purchase a non-degraded version of the application.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen

(U.S. Patent 6,041,316) as applied to claim 1 above, and further in view of Boyd et al.

(U.S. Patent Application Publication 2002/0081229). Allen does not disclose means to

produce unpleasant olfactory stimulus, but Boyd teaches means to produce olfactory

stimulus (Abstract; paragraphs 8, 13, and 14), which may be unpleasant. Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention to have the means to change the appearance or

performance of the specified application include means to produce unpleasant olfactory

stimulus, for the obvious advantage, taught by Allen, of encouraging a user to purchase

a non-degraded version of the application.

Claims 14-16, 25, and 26

Claims 14, 15, 16, and 25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Allen (U.S. Patent 6,041,316). As per claim 14, Allen discloses a

method of operating a trial software application, said trial application being associated

with a defined full application, said method comprising the steps of: providing the trial

application with a first set of instructions, embodied in a computer readable medium, for

causing a computer to generate a main program; and providing the trial application with a second set of instructions, embodied in a computer readable medium, for causing the computer to diminish, after receipt of the trial application by the computer, the performance of the main program over time and in accordance with a timed procedure in order to encourage a user of the computer to purchase said defined full application (Abstract; column 7, line 11, through column 8, line 56; the details of the computer readable medium following from the disclosed procedures). Computers have central processing units, which inherently have processing speeds, but Allen does not disclose means to diminish the performance of the main program by degrading said processing speed. However, Allen does disclose that many variations can be made in the arrangements shown, including the interconnections between the user terminals, the network, and the provider database, and the manner of partially degrading a particular type of data (column 8, line 57, through column 9, line 4). Degrading the processing speed is held to be such a variation, one of the numerous and functionally equivalent techniques the skilled artisan would have found obvious in view of the Allen disclosure, which teaches alternative solutions to the same basic problem addressed by Applicant. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the means to change the appearance or performance of the specified application include means to degrade the CPU processing speed, for the obvious advantage, taught by Allen, of encouraging a user to purchase a non-degraded version of the application.

As per claim 15, Allen discloses diminishing the performance of the program starting at the end of the defined period of time (note especially column 8, lines 42-45).

As per claim 16, Allen does not expressly disclose gradually diminishing the performance of the main program over a given time starting at the end of the defined period of time, but given Allen's disclosure of diminishing the performance after a set time (note especially column 8, lines 42-45), and Allen's disclosure of multiple levels of quality (column 5, line 27, through column 6, line 4), this is held to be an obvious variation in the manner of partially degrading data, given Allen's teaching of making such variations (column 8, line 57, through column 9, line 4), for the obvious advantage, taught by Allen, of encouraging a user to purchase a non-degraded version of the application.

As per claim 25, degrading the network bandwidth is held to be obvious over Allen for the reasons set forth in rejecting claim 1 above.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent 6,041,316) as applied to claim 14 above, and further in view of Gupta (U.S. Patent 6,459,364). Producing tactile stimulus is held to be obvious for the reasons set forth above in rejecting 23.

Claims 17-19, 27 and 28

Claims 17, 18, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent 6,041,316). As per claim 17, claim 17 is closely parallel to claim 1, and rejected on the same grounds.

As per claim 18, claim 18 is parallel to claim 15, and rejected on the same grounds.

As per claim 19, claim 19 is parallel to claim 16, and rejected on the same grounds.

As per claim 27, claim 27 is parallel to claim 22, and rejected on the same grounds.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent 6,041,316) as applied to claim 17 above, and further in view of Gupta (U.S. Patent 6,459,364). Producing tactile stimulus is held to be obvious for the reasons set forth above in rejecting 23.

Claims 20, 29 and 30

Claims 20, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent 6,041,316) in view of Gupta (U.S. Patent 6,459,364). As per claim 20, Allen discloses a method for: providing a user computer with a trial version of a program; allowing the user computer to use the full capacity of the trial version for a defined period to produce a defined performance; and after the defined period of time after receipt of the trial version by the user computer, diminishing the performance of the trial version in accordance with a timed procedure to encourage the user to purchase the full version (column 7, line 11, through column 8, line 56). Allen does not disclose the step of producing tactile stimulus, but Gupta teaches producing tactile stimulus (Abstract; column 2, lines 10-49; Figures 1 and 2). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention to have the step of diminishing the performance of the trial

version include means to producing tactile stimulus, for the obvious advantage, taught

by Allen, of encouraging a user to purchase a non-degraded version of the application.

As per claim 29, Allen does not expressly disclose degrading network bandwidth,

but does disclose accessing an audio database, and receiving degraded versions of

music "with an audio quality level at or below that produced over a standard telephone

line" (column 8, lines 6-15), which could surely be accomplished by in fact degrading the

bandwidth. Furthermore, Allen discloses that many variations can be made in the

arrangements shown, including the interconnections between the user terminals, the

network, and the provider database, and the manner of partially degrading a particular

type of data (column 8, line 57, through column 9, line 4). Degrading the bandwidth is

held to be such a variation, one of the numerous and functionally equivalent techniques

the skilled artisan would have found obvious in view of the Allen disclosure, which

teaches alternative solutions to the same basic problem addressed by Applicant.

As per claim 30, computers have central processing units, which inherently have

processing speeds, but Allen does not disclose diminishing the performance of the trial

version by degrading said processing speed. However, Allen does disclose that many

variations can be made in the arrangements shown, including the interconnections

between the user terminals, the network, and the provider database, and the manner of

partially degrading a particular type of data (column 8, line 57, through column 9, line 4).

Degrading the processing speed is held to be such a variation, one of the numerous

and functionally equivalent techniques the skilled artisan would have found obvious in

view of the Allen disclosure, which teaches alternative solutions to the same basic

problem addressed by Applicant. Hence, it would have been obvious to one of ordinary

skill in the art of electronic commerce at the time of applicant's invention to have

diminishing the performance of the trial version include degrading the CPU processing

speed, for the obvious advantage, taught by Allen, of encouraging a user to purchase a

non-degraded version of the application.

Response to Arguments

Applicant's arguments filed in the Appeal Brief of February 22, 2005 have been

fully considered but they are not persuasive. Applicant's arguments have also been

mooted in part by the new and changed grounds for rejection set forth above..

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Rose (U.S. Patent 5,708,709) discloses a system and method

for managing try-and-buy usage of application programs. Ronning (U.S. Patent

5,883,954) discloses a self-launching encrypted try before you buy software distribution

system. Schmidt et al. (U.S. Patent 6,354,839) disclose a refreshable Braille display

system. Cooper et al. (U.S. Patent Application Publication 2003/0088515) discloses

installing and controlling trial software.

Naka (Japanese Published Patent Application 10-275186 A) discloses a sales

system where a purchase is decided upon after trial use.

The anonymous article, "Preview Software Announces New Client/Server Technology for its TimeLOCK Electronic Software Distribution System," discloses providing a trial of software, with expiration after a number of days, on a specific date, or after other conditions are met.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone.number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 571-272-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

June 10, 2005